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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,182	09/24/2002	Ronald C. Carlson	27,672-02	6295

23452 7590 10/02/2003

PATENT DEPARTMENT
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EXAMINER

MCANULTY, TIMOTHY P

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,182

Applicant(s)

CARLSON, RONALD C.

Examiner

Timothy P McAnulty

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore:

- a. the adhesive as claimed in claim 4;
- b. the elastomeric band as claimed in claim 5;
- c. the elastomeric portion as claimed in claim 6;
- d. the method of adhering as claimed in claim 11;
- e. the method of providing an elastomeric band as claimed in claim 12; and
- f. the method of providing an elastomeric portion as claimed in claim 13;

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities: in line 14 of claim 1, --inverted-- should be inserted immediately before "oil filter canister." Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1,6-9, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krauss in view of Farrow et al.

Art Unit: 3682

Krauss discloses in figure 5, an oil containment apparatus in combination with an oil filter mounted on an engine; said containment apparatus comprising a circular first end; a circular second end; a peripheral wall inherently movable between a first containment position and a second folded position connecting said first end and said second end; a restraint proximate said first end having an elastomeric band; wherein a diameter of said second end is greater than a diameter of said first end. Krauss discloses that said oil containment apparatus is for a generic oil filter but does not specifically disclose said oil filter being an inverted oil filter. However, Farrow et al. teaches in figure 1, an inverted oil filter 15 mounted on an engine reservoir 10 wherein said inverted oil filter is inherently removable from said engine reservoir. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Krauss in view of Farrow et al. to provide said oil containment apparatus in combination with an inverted oil filter so as to reduce oil spillage when removing said inverted oil filter.

5. Claims 3,4,11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krauss in view of Farrow et al. as applied to claims 1,6-9, and 13-16 above and further in view of Wells.

Krauss discloses the basic apparatus as previously cited but does not disclose said restraint having a clamp or having an adhesive. However, Wells teaches in figure 1B and lines 27-38 of column 3, a containment apparatus comprising a first end; a second end; a peripheral wall connecting said first end and said second end; and a restraint having a buckle 17 and glue (not numbered). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Krauss in view of the teachings of Wells to include said restraint having a buckle to clamp said first end to said motor thus providing a

Art Unit: 3682

tighter mechanical seal therebetween. Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Krauss in view of the teachings of Wells to include said restraint having glue to attach a buckle to said peripheral wall so as to prevent said peripheral wall from being pulled out of said buckle.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Although Krauss may not specifically disclose said oil filter being an inverted oil filter, Farrow et al. teaches such an oil filter. The oil containment apparatus of the reference combination disclosed and taught by Krauss in view of Wells is structurally equal to the oil containment boot of the presently claimed invention and seeks to solve a similar problem, namely oil spillage upon removal of an oil filter.

7. Regarding the drawings, although adhesive and a clamp maybe common items in the art, their specific structure and location relative to the other elements of the oil containment boot are not depicted and are a major component to the claimed invention; and cannot be deemed to be minor variations or well-known and conventional parts as allowed in MPEP §608.02(f). As such, the drawings do not conform to 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims.

8. Additionally, it is well settled that the test for obviousness does not depend on whether the features of one reference can be bodily incorporated into the structure of another. Determination of obviousness is not limited to merely the structure of the respective reference but includes the concepts fairly contained within those references and whether those concepts would suggest to one skilled in the art the modifications of the claims. *In re Van Beckum*, 169 USPQ 47 (CCPA 1971).

Art Unit: 3682

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art regarding inverted oil filters in general:

US Patent No. 6,214,215 to Berkey et al.

US Patent No. 5,374,355 to Habiger et al.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

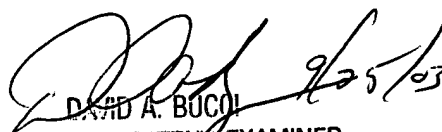
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

• Art Unit: 3682

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9326 for regular communications and 703.872.9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm 
September 23, 2003


DAVID A. BUCCI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3000